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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,130

09/22/2003

Hans-Ulrich Maier

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04/04/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

MCCARTHY, CHRISTOPHER S

ART UNIT

PAPER NUMBER

2113

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/666,130	Applicant(s) MAIER ET AL.	
	Examiner Christopher S. McCarthy	Art Unit 2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,2, 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Software modules and programs, per se, are not patentable. "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)." A suggestion is to place all programs and software modules on a computer readable medium and to consists of computer readable instructions to execute the desired result.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bealkowski et al. U.S. Patent 5,410,699.

As per claim 1, Bealkowski teaches a method for recovering data in a data processing system in which the recovery is carried out exclusively in predetermined units or installations, wherein a recovery program is executed in the data processing system (column 3, lines 1-7), wherein a test procedure of predefined hardware features of the data processing system is executed (column 3, lines 19-22; column 7, lines 16-19), wherein the recovery carried out is non-destructive (column 10, lines 47-49, wherein an update to the system does not teach an overwrite or destruction of the prior version), and wherein all the features that are characteristic of the data and the system are stored in a control file of the recovery program (column 3, lines 19-22; column 7, lines 16-19).

As per claim 2, Bealkowski teaches a method as claimed in claim 1, wherein the test procedure analyzes special hardware features of the data processing system that are stored in a predefined memory area of the data processing system and, if the special hardware features match with defaults in the control file, execution of the recovery program is continued and, if not, execution of the recovery program is aborted (column 12, lines 1-7; column 3, lines 53-66).

As per claim 3, Bealkowski teaches a method as claimed in claim 2, wherein the special hardware features have been stored as data strings in BIOS of the data processing system (column 7, lines 7-24).

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As per claim 7, Bealkowski teaches a device for carrying out a method as claimed in claim 1, wherein the data processing system has a processor module, a working memory and additional storage and input media for executing the recovery program (column 4, line 64 – column 5, line 18).

As per claim 8, Bealkowski teaches a software module for carrying out a method as claimed in claim 1, wherein the software module is programmed to have program steps with which the recovery program is executed in the data processing system (column 3, lines 1-7).

As per claim 9, Bealkowski teaches a data carrier with a software module as claimed in claim 8, wherein the data carrier contains at least one of unencrypted and encrypted data to be recovered as well as the recovery program including the control file, and wherein the data carrier is configured to be read into the data processing system by means of a data input device (column 3, lines 10-18, 41-52).

As per claim 10, Bealkowski teaches a data carrier with a software module as claimed in claim 9, wherein the data input device comprises a reader (column 5, lines 11-19).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bealkowski in view of Grawrock U.S. Patent Application Publication US2002/0087877.

As per claim 4, Bealkowski teaches a method as claimed in claim 1. Bealkowski does not explicitly teach wherein the data to be recovered is at least in part encrypted data. Grawrock does teach wherein the data to be recovered is at least in part encrypted data (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption process of Grawrock to the recovery process of Bealkowski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkowski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

As per claim 5, Bealkowski in view of Grawrock teaches a method as claimed in claim 4 as cited above. Bealkowski does not explicitly teach wherein the data to be recovered is at least in part unencrypted data. Grawrock does teach wherein the data to be recovered is at least in part unencrypted data (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption process of Grawrock to the recovery process of Bealkowski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkowski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

As per claim 11, Bealkowski teaches a data carrier according to claim 9. Bealkowski does not teach wherein the data carrier contains both unencrypted data and encrypted data to be recovered. Grawrock does teach (paragraph 0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the data encryption

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process of Grawrock to the recovery process of Bealkoski. One of ordinary skill in the art would have been motivated to combine the data encryption process of Grawrock to the recovery process of Bealkoski because Grawrock teaches using the encryption of data to protect the integrity of the data being transferred (paragraph 0018); an explicit desire of Bealkowski (column 11, lines 56-57).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. McCarthy whose telephone number is (571)272-3651. The examiner can normally be reached on M-F, 9 - 5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571)272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 29, 2006


ROBERT BEAUSOLIEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100